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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,886	11/30/2001	David Elderfield		2771

7590 01/12/2004
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Dix Hills, NY 11746

EXAMINER

LEE, SEUNG H

ART UNIT PAPER NUMBER

2876

DATE MAILED: 01/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/996,886

Applicant(s)

ELDERFIELD, DAVID

Examiner

Seung H Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☒ Interview Summary (PTO-413) Paper No(s). 10/23/03.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. Receipt is acknowledged of the amendment filed on 29 August 2003, which has been entered in the file.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 12-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Price-Francis (US 5,815,252, of record) in view of Yu et al. (US 5,903,804, of record)(hereinafter referred to as 'Yu') and Funk et al. (US 6,296,169, of record)(hereinafter referred to as 'Funk').

Price-Francis teaches a personal data carrier or optical card (25) comprising a photo image and a fingerprint of individual, a code (29) for each identity card representing name, account number, date of birth, etc. in which these information does not have features of facial and fingerprint image, a display (42) for displaying information such as the photo image or facial image and travel history, etc., a reader/writer for reading information from individual's fingerprint (see Figs. 1-5; col. 2, lines 30-44; col. 3, lines 18-30; col. 4, line 15 – col. 7, line 47).

However, Price-Francis fairly teaches that the fingerprint is store at the database wherein the database is providing the validity of the fingerprint obtained from user(s).

Yu teaches an authentication center (24) comprising biometric database (44) wherein the authentication center is comparing (116) the acquired biometric data (104) with the retrieved biometric data from the database (44) according to the identity of user such as user's name or user's ID (107) (see Figs. 1-5; col. 4, line 30- col. 14, line 11).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Yu to the teachings of Price-Francis in order to provide an improved and an enhanced system means for employing the centralized authentication system for authenticating/verifying of the user at the server side by comparing the biometric information obtained from the user with the biometric data retrieved from the biometric database according to the user name or ID. Moreover, such modification would provide an additional security means for comparing the acquired biometric data at the terminal with the biometric data retrieved from the biometric database. Furthermore, such modification would provide flexible means wherein the terminal equipped with the card reader and biometric data scanner can be installed at any place where the authenticating of user is necessary by connecting the centralized authenticating system including database storing users biometric data therein.

Although, Price-Francis as modified by Yu teaches the authentication system using the biometric data stored in the data carrier, they fail to particularly teach that the data carrier is a passport.

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However, Funk teaches the biometric data such as fingerprint, voiceprints, and eye prints or retinal image are recorded on a passport (see col. 2, lines 39-60).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Funk to the teachings of Price-Francis/Rockwell in order to improve a security at the airport by authenticating the biometric data wherein the biometric data is stored in the passport.

Although, Price-Francis/Yu/Funk teaches the data carrier such as optical card or passport contains the photo image and fingerprint thereon, they fail to particularly teach that the photo image is on one side of the substrate and the fingerprint is on the opposite side of the substrate. However, it would have been an obvious design variation well within the ordinary skill in the art failing to provide any unexpected results for printing fingerprint and/or facial image on different sides/pages of the passport/data carrier since operator(s) can verify an identity of the holder/bearer of the passport/data carrier using the facial image and/or fingerprint printed thereon.

Response to Arguments

4. Applicant's arguments with respect to claims 12-19 have been considered but are moot in view of the new ground(s) of rejection.

In response to the applicant's argument that "*...it is a separate and different code which does not include any features of the fingerprint....*" (see page 9, line 12+), the Examiner respectfully request to review Price-Francis reference wherein Price-Francis

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teaches a code containing other than facial and/or fingerprint information as discussed in paragraph 3 above.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the facial image and the fingerprints are independent from one another, each of them can occupy the whole side or the whole page) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communication from the examiner should be directed to Seung H. Lee whose telephone number is (703) 308-5894, and new telephone number (571) 272-2401 will be effective on 15 January 2004. The examiner can normally be reached on Monday to Friday from 7:30 AM to 4:00 PM.

If attempt to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (703) 305-3503. The fax-phone number for this group is (703) 872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [seung.lee@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.


Seung H. Lee
Art Unit 2876
January 6, 2003


MICHAEL G. LEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800